

ESTTA Tracking number: **ESTTA480516**Filing date: **06/27/2012**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Intelligent Mechatronic Systems Inc.		
Entity	Corporation	Citizenship	Canada
Address	435 King Street North Waterloo, ONT N2J2Z5 CANADA		

Attorney information	John A. Cullis Neal, Gerber & Eisenberg LLP Two North LaSalle Street, Suite 1700 Chicago, IL 60602 UNITED STATES jcullis@ngelaw.com, ljames@ngelaw.com, knye@ngelaw.com, mbenson@ngelaw.com Phone:312-269-8000
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Registration Subject to Cancellation

Registration No	3960730	Registration date	05/17/2011
International Registration No.	NONE	International Registration Date	NONE
Registrant	IMST GmbH Carl-Friedrich-Gauss-Str. 2 47475 Kamp-Lintfort GERMANY		


Goods/Services Subject to Cancellation

Class 009. All goods and services in the class are cancelled, namely: On-board electronic devices/instruments for automobiles, namely, devices for wireless radio transmission, antennas, senders, receivers, microphones, speakers, amplifiers, and electronic interface modules for wireless communication and/or transmission of signals of the automobile electronic system and of multimedia signals (also for linking automobiles with each others and/or with external systems)
Class 042. All goods and services in the class are cancelled, namely: Technical development services for others, namely, design and development of on-board electronic devices/instruments for automobiles and/or for wireless communication and transmission of signals of automobile electronic systems and multimedia signals, including design and development of software for automobile computers and automobile electronic systems providing the aforementioned functions

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	85079068	Application Date	07/07/2010
Registration Date	NONE	Foreign Priority Date	01/12/2010
Word Mark	CONNECTED CAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: Software and computer hardware, namely, sensors, computers, and wireless transceivers to provide connectivity within the vehicle, between vehicles, and with external entities, namely, personal media servers, in addition to tactile, audible, and visual interfaces to interact with occupants of the vehicle</p> <p>Class 039. First use: Real time navigation and traffic reports, namely, GPS navigation and traffic information services</p> <p>Class 042. First use: Vehicle diagnostics, namely, automotive diagnostic services featuring computer software for use by independent automotive repair personnel; voice-interactive personal information management in network based systems and on-board consumer electronic devices, namely, computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for searching and retrieving information from databases and computer networks</p>		

Attachments	85079068#TMSN.jpeg (1 page)(bytes) Petition_for_Cancellation_for_CONNECTED-CAR.pdf (6 pages)(16179 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/John A. Cullis/
Name	John A. Cullis
Date	06/27/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No.: 3,960,730)	
Mark: CONNECTED-CAR)	
Registered on May 17, 2011)	
)	
INTELLIGENT MECHATRONIC SYSTEMS INC.,)	
)	
Petitioner,)	PETITION FOR CANCELLATION
v.)	
)	
IMST GmbH,)	
)	
Registrant.)	

This Petition for Cancellation is submitted in the matter of Registration No. 3,960,730, to IMST GmbH, for the mark CONNECTED-CAR for use in connection with “on-board electronic devices/instruments for automobiles, namely, devices for wireless radio transmission, antennas, senders, receivers, microphones, speakers, amplifiers, and electronic interface modules for wireless communication and/or transmission of signals of the automobile electronic system and of multimedia signals (also for linking automobiles with each others and/or with external systems)” in International Class 9 and “technical development services for others, namely, design and development of on-board electronic devices/instruments for automobiles and/or for wireless communication and transmission of signals of automobile electronic systems and multimedia signals, including design and development of software for automobile computers and automobile electronic systems providing the aforementioned functions,” in International Class 42, which was registered on May 17, 2011 (the “Subject Mark”).

Intelligent Mechatronic Systems Inc. (“Intelligent Mechatronic”), a Canadian corporation having a place of business at 435 King Street North, Waterloo, Ontario 2J2Z5, believes that it will

be damaged by the continued registration of the Subject Mark and, therefore, petitions to cancel the same on the following grounds:

1. Since at least as early as 2001, Intelligent Mechatronic, has provided leading intelligent vehicle solutions through intelligence on drivers, vehicles, and transportation infrastructure.

2. On January 12, 2010, Intelligent Mechatronic filed Canadian trademark Application No. 1465549 for the mark CONNECTED CAR for use in connection with “Software and hardware, namely sensors, computers, and wireless transceivers to provide wireless internet, cell phone, satellite and GPS connectivity within the vehicle, between vehicles, and with external entities, in addition to user interface hardware (tactile, audible and visual)” and “Collecting, analyzing, providing, and sharing information namely infotainment, vehicle diagnostics, telematics, network (social) connectivity, on-road and roadside events, real-time navigation and traffic reports, and voice-interactive personal information management on network based systems or on-board consumer electronic devices” based on proposed use of the mark in Canada.

3. Intelligent Mechatronic’s Canadian trademark Application No. 1465549 is presently pending.

4. On July 7, 2010, Intelligent Mechatronic filed U.S. Application No. 85/079,068 for the mark CONNECTED CAR for use in connection with “Software, hardware, and supporting infrastructure to provide connectivity within the vehicle, between vehicles, and with external entities” and “Providing information including infotainment, vehicle diagnostics, network (social) connectivity, real-time navigation and traffic reports, and voice-interactive personal information management on network based systems or on-board consumer electronic devices” alleging in the application a bona fide intention to use the mark in commerce in under 15 U.S.C. Section 1051(b)

and claiming priority to its foreign filing of Canada Application No. 1465549 under 15 U.S.C. Section 1126(d) (the “Intelligent Mechatronic U.S. ‘068 Application”).

5. Pursuant to 15 U.S.C. § 1126(d), the priority date of the Intelligent Mechatronic U.S. ‘068 Application is January 12, 2010.

6. On May 27, 2010, Respondent filed U.S. Application No. 79/082,251 for the mark CONNECTED-CAR for use in connection with “On-board electronic devices/instruments for automobiles for wireless communication and/or transmission of signals of the automobile electronic system and of multimedia signals (also for linking automobiles with each others and/or with external systems)” in International Class 9 and “Technical development services for others with respect to on-board electronic devices/instruments for automobiles and/or for wireless communication and transmission of signals of the automobile electronic system and of multimedia signals, including development of software for automobile computers and automobile electronic systems providing the aforementioned functions” in International Class 42 claiming priority to Respondent’s International Registration No. 1,037,765 (“Respondent’s U.S. ‘251 Application”).

7. Respondent’s International Registration No. 1,037,765 was registered March 3, 2010.

8. Respondent’s U.S. ‘251 Application issued on May 17, 2011, as U.S. Registration No. 3,960,730 (the “Subject Registration”).

9. Pursuant to 15 U.S.C. §1141(g), the priority date of the Subject Registration is March 3, 2010.

10. Therefore, the Intelligent Mechatronic U.S. ‘068 Application has an earlier priority date than the Subject Registration.

11. Given the similarity between the Subject Mark and Intelligent Mechatronic's CONNECTED CAR mark and the similarity of the goods and services set forth in the Subject Registration and Intelligent Mechatronic's U.S. '068 Application, Intelligent Mechatronic believes that its '068 Application, which is presently pending, will be refused registration in view of the Subject Registration.

12. Registrant's continued use and registration of the term CONNECTED-CAR as a trademark is likely to cause confusion or mistake, or to deceive purchasers, in that purchasers would be likely to believe Registrant's goods and services are Intelligent Mechatronic's goods and services, or are in some way legitimately connected with, sponsored by, or approved by Intelligent Mechatronic in violation of 15 U.S.C. § 1052(d).

13. Therefore, Registrant's continued registration of the CONNECTED-CAR mark will damage Intelligent Mechatronic, and, on that basis, Intelligent Mechatronic requests cancellation of U.S. Registration No. 3,960,730.

WHEREFORE, Petitioner requests that U.S. Registration No. 3,960,730 be cancelled in its entirety and that this Petition for Cancellation be sustained.

Petitioner requests that the requisite filing fee of \$600.00 be charged to the deposit account of Neal, Gerber & Eisenberg, LLP, Account No. 502261.

Respectfully submitted,

Date: June 27, 2012

By: /John A. Cullis/
One of the Attorneys for
Intelligent Mechatronic Systems, Inc.
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CERTIFICATE OF SERVICE

I, Lawrence E. James, Jr., an attorney, state that, pursuant to 37 CFR § 2.119, I caused a copy of the foregoing Petition for Cancellation to be served upon:

IMST GmbH
Carl-Friedrich-Gauss-Str. 2 47475 Kamp-Lintfort
Federal Republic of Germany

with a copy to

Gary M. Nath
The Nath Law Group
112 S. West Street
Alexandria, VA 22314

via Federal Express, on June 27, 2012.

/Lawrence E. James, Jr. /
Lawrence E. James, Jr.